

REMARKS

In the response filed May 27, 2009, Applicants provided a translation into the English language of a certified copy of Applicants' Japanese priority document filed March 19, 2003, along with a certification of the accuracy of the translation by the translator. Based upon this filing, Applicants indicated that the Auguste publication may not properly be used as a reference against the present application.

For the convenience of the Examiner, this paper will point out further details of disclosure in the priority document and the application as filed which supports various claims herein and of aspects of the present invention which are not rejectable over the Auguste disclosure.

Claim 1 in the application, as amended on May 27, 2009, is supported in priority document claim 1, which describes structures (1) and (3), and in priority document claim 2, which describes the relative content of tetraquistrimethylsiloxysilane to methyltrimethicone.

Claim 3 is supported in the priority document, paragraph [0026] ("various volatile solvents"). The temperature and pressure limitations "at 25 °C and 1 atm" are commonly used conditions for defining physicochemical property of a substance.

Claims 4 and 5 are supported in paragraphs [0026] and [0055] of the priority document. The monohydric alcohols having 2 to 3 carbon atoms are supported by "lower alcohol such as ethanol and isopropanol" listed in paragraph [0026], and the hydrocarbons having 10, 11 and 16 carbon atoms are supported by "isododecane, isodecane, and isohexadecane" listed in paragraph [0026]. The cyclic dimethylpolysiloxane having 5 silicon atoms is supported by "decamethylcyclopentasiloxane" listed in paragraph [0055].

The synergistic effect of the combination of M4Q and M3T in the present invention is unexpected based upon the disclosure of Auguste. Even more unexpected is the effect caused by

the combinatory use of M4Q, M3T, and a volatile solvent – such as refreshing feel, no greasiness and improved feel at the time of application of the cosmetic. With regard to claims 12, 25, and 26, it is acknowledged that Auguste describes polyisobutene. However, Auguste describes, as an alternative to the polyisobutene, hydrocarbon-based oils of mineral origin. See August paragraph [0199], line 2. Example 7 of the present application is a lipstick comprising 40% of M4Q and 18% of ceresin, which is a hydrocarbon-based oil of mineral origin. Comparative Example 8 in Applicants' specification is a lipstick which was prepared according to the same formulation as that of Example 7 except that it comprises ceresin in place of M4Q. As shown in the Table set forth on pages 70-71 of the specification, the composition of Example 7 is far superior to that of Comparative Example 8. This advantage would not have been expected by a person with ordinary skill in the art from Auguste, which teaches hydrocarbon oils of mineral origin as an alternative to polyisobutene.

Claim 13. The cosmetic of claim 13 herein relates to a solid makeup cosmetic. The solid cosmetic flows when scrubbed, as described in the specification, page 26, lines 12-13. Examples 9 and 10 are foundations embodying the solid makeup cosmetic. As shown in the specification, in the Table on page 78, the foundations of the present invention provide excellent sensory feels to the skin. Auguste describes a foundation in his Example 1. However, the formulation of the Auguste foundation is entirely different from those of Examples 9 and 10 herein. The formulation specified in Applicants' claim 13 would not have been conceived by a person of ordinary skill in the art based upon the disclosure of Auguste. Summary: the specific combination of components (A) to (F) specified in claim 13 is not described in Auguste. It is not obvious from Auguste that the combination makes a solid cosmetic which flows when it is scrubbed.

Claim 15 is supported in paragraph [0027] in the priority document.

Claim 16 is supported in paragraph [0033] in the priority document.

Claims 17-22 now relate to a method of preparing a cosmetic comprising M4Q prepared by a specific method. M4Q thus prepared contains, without having been purified, little impurity of 1,1,1,5,5,5-hexamethyl-3-trimethylsiloxy-3-hydroxytrisiloxane. Neither Auguste nor Kuroda mentions a method of producing M4Q. Auguste is totally silent on a method of producing M4Q.

Claim 23 is supported in priority document claim 1, which describes tetraquistrimethylsiloxysilane and methyltrimethicone, and in priority document paragraph [0025], which teaches the recited amounts of those components in the claimed cosmetic composition.

Claim 24. See priority document claim 1, structures (1) and (3), and claim 2, and Example 43 and paragraph [0025] ("Further, one of the characteristics of the aforesaid volatile silicones (1), (2) and methyltrimethicone is that they cause significantly reduced dry feel (feeling of dryness), which dry feel is peculiar to conventionally used volatile silicones, to be useful to improve safety at the time of use"). The skin feels strained when it is dry, and the terminology "straining feel" is used as a synonym of "dry feel" in the cosmetic technical field.

CONCLUSION

In view of the above Remarks and the Amendment filed March 27, 2009, it is believed that claims 1, 3-5, 12, 13, and 15-29 are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No.: 10/549,704

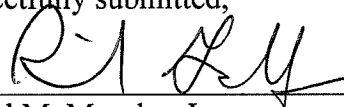
Docket No.: 5521-0116PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: June 16, 2009

Respectfully submitted,

By

 #28,781

Gerald M. Murphy, Jr.

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant